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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/938,650	08/27/2001	Richard A. Mason	9559-001-27	2532
7590	11/18/2003		EXAMINER	
Laura D Nammo Patton Boggs LLP 8484 Westpark Drive Suite 900 McLean, VA 22102			CRONIN, STEPHEN K	
			ART UNIT	PAPER NUMBER
			3727	

DATE MAILED: 11/18/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/938,650	MASON, RICHARD A.
	Examiner Stephen K. Cronin	Art Unit 3727

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 28 July 2003.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-19 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-19 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. _____.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) The translation of the foreign language provisional application has been received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____

4) Interview Summary (PTO-413) Paper No(s). _____

5) Notice of Informal Patent Application (PTO-152)

6) Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1 the newly inserted limitation "the retaining cavity is configured and dimensioned to hold a handgun therein", is indefinite. Handguns available for sale today come in various sizes, and shapes that range from a compact .22 caliber pistol which will fit in the palm of a users hand to high power .50 AE caliber semi-automatic pistols which weigh upwards of 8 lbs., are two feet in length. Handguns also come in various shapes designated by there types such as revolvers, single shots and semi-automatics. It therefore is unclear what size and shape or range of size and shapes of applicants claimed retaining cavity would be necessary to meet the limitation of "configured and dimensioned to hold a handgun therein". Since applicant's specification fails to further define this limitation, it cannot be relied upon for overcoming the structure set forth by the prior art since it is unclear whether applicant intended to exclude the size and shape taught by the prior art or not.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 3727

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1-5 and 9-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zander 5,116,306.

Zander teaches a holster comprising a flexible rectangular elastic sheath 12 with a retaining cavity 30, a harness 16 with first 34 and second 38 straps, and fixable attachment means 42, 46. Zander therefore discloses the claimed invention except for the retaining cavity being configured and dimensioned to hold a handgun therein. It would have been an obvious matter of design choice to size the retaining cavity to hold a handgun as claimed, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955). It further would have been an obvious matter of design choice to make the different portions of the retaining cavity of whatever form or shape was desired or expedient. A change in form or shape is generally recognized as being within the level of ordinary skill in the art, absent any showing of unexpected results. *In re Dailey et al.*, 149 USPQ 47.

3. Claims 1-5, 9-13 and 15-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Simon 4,674,664.

Simon teaches a holster comprising a flexible rectangular sheath 12 with a retaining cavity 22, a harness 14 with first 14 and second 16 straps fixedly attached in front of the user and to the sheath, and a holder 36. Simon therefore discloses the claimed invention except for the retaining cavity being configured and dimensioned to

hold a handgun therein. It would have been an obvious matter of design choice to size the retaining cavity to hold a handgun as claimed, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955). It further would have been an obvious matter of design choice to make the different portions of the retaining cavity of whatever form or shape was desired or expedient. A change in form or shape is generally recognized as being within the level of ordinary skill in the art, absent any showing of unexpected results. *In re Dailey et al.*, 149 USPQ 47.

4. Claims 1-5, 9-12 and 15-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mott et al. 5,806,742.

Mott teaches a holster comprising a rectangular sheath 16 with a retaining cavity 18, a harness 40 with first 54 and second 52 straps fixedly attached in front of the user 44, 46, 50, and to the sheath (see figure 3), and a holder 34. Mott therefore discloses the claimed invention except for the retaining cavity being configured and dimensioned to hold a handgun therein. It would have been an obvious matter of design choice to size the retaining cavity to hold a handgun as claimed, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955). It further would have been an obvious matter of design choice to make the different portions of the retaining cavity of whatever form or shape was desired or expedient. A change in form or shape is generally recognized as being within

the level of ordinary skill in the art, absent any showing of unexpected results. *In re Dailey et al.*, 149 USPQ 47.

5. Claims 1-6, 10-13 and 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wu 6,216,932.

Wu teaches a holster comprising a flexible rectangular sheath 3 with a retaining cavity, a harness 1 with first and second straps fixedly attached in front of the user and releasable attached to the sheath 21. Wu therefore discloses the claimed invention except for the retaining cavity being configured and dimensioned to hold a handgun therein. It would have been an obvious matter of design choice to size the retaining cavity to hold a handgun as claimed, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955). It further would have been an obvious matter of design choice to make the different portions of the retaining cavity of whatever form or shape was desired or expedient. A change in form or shape is generally recognized as being within the level of ordinary skill in the art, absent any showing of unexpected results. *In re Dailey et al.*, 149 USPQ 47.

6. Claims 1-8, 10-13 and 15-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Famorca 5,544,745.

Famorca teaches a holster comprising a flexible rectangular sheath 5 with a retaining cavity 15, a harness with first and second straps 53 fixedly attached in front of the user, and to the sheath (see figure 3), releasable adjustment means 49, 55, of hook

and loop material and a holder 39. Famorca therefore discloses the claimed invention except for the retaining cavity being configured and dimensioned to hold a handgun therein. It would have been an obvious matter of design choice to size the retaining cavity to hold a handgun as claimed, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955). It further would have been an obvious matter of design choice to make the different portions of the retaining cavity of whatever form or shape was desired or expedient. A change in form or shape is generally recognized as being within the level of ordinary skill in the art, absent any showing of unexpected results. *In re Dailey et al.*, 149 USPQ 47.

Response to Arguments

7. Applicant's arguments filed July 28, 2003 have been fully considered but they are not persuasive. Applicants newly added limitation to claim 1 setting forth that the "sheath" of the holster "extends across a portion of the upper back" is clearly met by all of the prior art references relied upon in the above rejections. All of the prior art relied upon above covers a portion of the upper back of a wearer. As to the limitation that "the retaining cavity is configured and dimensioned to hold a handgun therein", this limitation is indefinite for the reasons stated above and fails to differentiate the structure of the claimed invention over that taught by the prior art. It is further noted that given the various size and shapes of currently available handguns available on the market, the

size and shapes of the various pockets taught by the relied upon prior art would appear to be able to hold certain handguns in the manner as set forth in the claims.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen K. Cronin whose telephone number is 703-308-4296. The examiner can normally be reached on M-TH 7:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lee W. Young can be reached on 703-308-2572. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.



Stephen K. Cronin
Primary Examiner
Art Unit 3727

skc